



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

LEWIN et al

Atty. Ref.: 124-1118; Confirmation No. 4506

Appl. No. 10/534,495

TC/A.U. 2886

Filed: May 10, 2005

Examiner: R. Punnoose

For: STRUCTURED LIGHT PROJECTOR

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October 29, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

This Request for Reconsideration is responsive to the Official Action mailed July 29, 2008 (Paper No. 20080220), the date of response to which is October 29, 2008.

Claims 1-37 stand rejected in the outstanding Official Action. No amendments to claims 1-37 are offered and therefore claims 1-37 remain in this application.

Telephone Interview 10/29/08 with SPE Chowdhury

Applicants note that the Examiner has made improper rejections to this application in previous Official Actions: Specifically note the Quayle Action mailed October 19, 2007 objecting to the title and the defects therein as pointed out in the previously filed Request for Reconsideration filed November 13, 2007, the Examiner's filing of a Notice of Non-Compliant Amendment mailed February 7, 2008, the Interview Summary Record reporting the telephone

interview conducted February 11, 2008 in which SPE Chowdhury confirmed the impropriety of the Examiner's "Notice of Non-Compliant Amendment" and its withdrawal, and the latest Official Action mailed July 29, 2008 in which the Examiner again alleges that the title of the invention is in the improper location and that sub-heading need to be added.

Applicants undersigned representative contacted SPE Chowdhury on October 28 and conducted a telephone interview on October 29 and received confirmation that the Examiner will withdraw the current improper objections and, when a patent on one of the co-pending applications actually issues, the office will reinstitute the provisional double patenting rejection. SPE Chowdhury's assistance and assurance are very much appreciated.

On page 6, section 9 of the Official Action, the specification is objected to because "the title of the invention is not placed at the top of the first page of the specification."

As previously pointed out to the Examiner in the Request for Reconsideration filed November 13, 2007, the Patent Office is objecting to the arrangement of the specification. Applicant's have previously noted that the objection to the arrangement appears to be an indication that the originally filed specification and drawings (transmitted from WIPO) does not meet the formality requirements of the U.S. Patent and Trademark Office. The Patent Office was reminded that the U.S. Patent and Trademark Office must comply with all articles of the Patent Cooperation Treaty (PCT) including Article 27. It has been held that:

"if the rule and interpretation of the PTO conflicts with the PCT, it runs afoul of Article 27 of the PCT which provides in part:

- (1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations." Caterpillar Tractor v. Commissioner, 231 USPQ 590, 591 (EDVA 1986).

The Patent Office has referenced this decision in the Official Gazette dated September 9, 1986 (1070 TMOG 5).

As a consequence, and as confirmed in the telephone interview with SPE Chowdhury, the Examiner may not require specification format changes as long as the originally submitted documents comply with the PCT requirements. Inasmuch as this specification and these drawings were forwarded for WIPO, by definition, they meet the PCT requirements (they are not forwarded until they meet PCT requirements.). Therefore, the objection to the specification is again respectfully traversed and reconsideration thereof is respectfully requested. Applicant's undersigned representative was assured by SPE Chowdhury that all objections to the present application would be withdrawn.

On page 4, section 8 of the outstanding Official Action, the Examiner confirms that claim 1 contains allowable subject matter and would be allowable. This notice of allowance of claim 1 and presumably claims 2-37 dependent thereon is very much appreciated.

Beginning on page 2 and extending through page 3 of the Official Action, the Examiner institutes a provisional rejections of claims 1-37 on the grounds of non-statutory Obviousness-type Double Patenting ("ODP") with respect to Applicants' co-pending Applications Serial No. 10/534,494 ('494) and Serial No. 10/534,498 ('498). It is noted that both above co-pending applications were filed on March 10, 2005, which is the filing date of the present application.

The Examiner's attention is directed to the Manual of Patent Examining Procedure (MPEP) Section 804 (page 800-17 in the online version of the MPEP) which states that in the case of non-statutory double patenting rejections, "if both applications are filed on the same day, the examiner should determine which application claims the base invention and which

application claims the improvement (added limitations).” The MPEP specifically states that “the ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.”

Applicants note that none of the three co-pending applications have resulted in an issued patent, although the Issue Fee has been paid in co-pending ‘494 application. Applicants understand that a patent will issue on the ‘494 co-pending application in a reasonable period of time.

Pursuant to the MPEP, this Examiner should have determined which application claims the base invention and which application claims the improvement. Applicants’ review of the claims indicates that the claims in the present application relate to a spot projector apparatus, i.e., the “base invention,” whereas the claims in ‘498 relate to a ranging apparatus which incorporates a spot projector apparatus. Accordingly, as between these applications, the present application claims the base invention and the ‘498 application claims the improvement.

In view of the requirements of the MPEP and the fact that the Issue Fee has been paid in the ‘494 pending application, it was suggested and agreed to in the interview with SPE Chowdhury that the Examiner will withdraw the improper objections to the specification and, when co-pending Application 10/534,494 actually issues as a patent, reinstitute the obviousness-type double patenting rejection. Applicants will then file a terminal disclaimer in the present application (clearly avoiding any requirement of filing terminal disclaimers in all three related applications) which should permit the present application to then pass to issue.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-37 are in condition for allowance and notice to that effect is respectfully requested. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of the claims, he is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

NIXON & VANDERHYTE P.C.

By: _____

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